

Attorney Docket No.: 3386P002X2

Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:

David L. Gilmour, et al.

Application No.: 09/703,189

Filed: October 31, 2000

For: METHOD AND SYSTEM FOR
ADDRESSING A COMMUNICATION
FOR TRANSMISSION OVER A
NETWORK BASED IN THE
CONTENT THEREOF

Examiner: Nguyen, Thanh T.

Art Unit: 2144

Confirmation no.: 2756

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Pre-Appeal Brief Request for Review

Sir:

Applicants respectfully request pre-appeal brief review of the Final Office Action dated August 17, 2006. Submitted with this request is a Notice of Appeal under 37 C.F.R. § 41.31 and required fee.

Claims 1-28 are rejected under 35 U.S.C. § 102(e) as being anticipated by Herz et al. (U.S. Patent No. 5,835,087, herein referred to as "Herz").

The rejections in the Final Office Action are improper, due to clear factual errors by the examiner and/or the omission of essential elements required to establish a *prima facie* rejection.

The present invention generally relates to a technique for addressing a communication, and more particularly, to automatically suggesting a recipient of the communication to the sender. Claim 1 is representative of Applicants' independent claims for purposes of discussing the present rejections. Claim 1 recites:

1. A method of addressing a communication for transmission over a network, the method including:
 - accessing a descriptive profile of a potential recipient of the communication;
 - identifying the potential recipient as a suggested recipient of the communication based on an evaluation of a correspondence between content of the communication and content of the descriptive profile of the potential recipient; and
 - presenting the suggested recipient to a sender of the communication for selection as a confirmed recipient after the sender has composed a draft of the communication and before transmission of the communication to an actual recipient**, the suggested recipient being presented in conjunction with an indication of the correspondence between the content of the communication and the content of the descriptive profile of the potential recipient. (Emphasis added).

Herz does not disclose or suggest such functionality. In particular, Herz fails to disclose or suggest identifying a potential recipient of a communication as a suggested recipient based on an evaluation of a correspondence between content of the communication and content of the descriptive profile of the potential recipient, and then presenting the suggested recipient to a sender of the communication for selection as a confirmed recipient after the sender has composed a draft of the communication and before transmission of the communication to an actual recipient.

Applicants maintain all of their arguments in their response to the Final Office Action, filed on 10/19/2006 (see pages 2-7), and those arguments are incorporated herein by reference. Applicants will therefore limit their remarks in this Request to responding to the Advisory Action.

In the Advisory Action mailed on 11/17/2006, the Examiner asserts:

Applicants argue that the target object can not be a recipient. In response to Applicant's argument, the Patent Office maintain [sic] the rejection because Hertz discloses a target object which is receive [sic] an e-mail. Therefore, Examiner interpreted a target object as a recipient [sic] as shown in in [sic] col.6, lines 12-13 is defined (the target object can include, but are [sic] not limited to: e.g., e-mail to receive, or another person to a correspond with) having a function as recipient. **Therefore, the Examiner interpreted "target object" as a "recipient".**

Applicants argue that Hertz does not teach and evaluation of a correspondence between content of these profiles of potential recipient and content of the communication. In response to Applicant's argument, the Patent Office maintain [sic] the rejection because **Hertz teaches an evaluation of a correspondence between content of these profiles of potential recipient [sic] and content of the communication** as shows [sic] in col. 5, lines 7-20, and col. 18, lines 7-36. Hertz clearly the applicant claimed invention. Advisory Action, continuation sheet (emphasis added).

Applicants maintain that the Examiner's interpretation of Herz is inconsistent with the claim language. Consider:

Herz relates to a system that automatically identifies objects (e.g., information or other people) that a user may be interested in or find "desirable". To accomplish this, the system automatically constructs two types of profiles: "target profiles" and "target profile interest summaries". A target profile is built for each "target object" (e.g., information or a person) that users might find desirable, to describe that object. A "target profile interest summary" is generated for each user, to summarize the types of things (target objects) that the particular user is interested in. The system then evaluates the target profiles against the users' target profile interest summaries to generate a user-customized ranked list of target objects most likely to be of interest to each user. Each user is then allowed to select from the list of target objects. See Herz abstract and col. 5, lines 7-20.

Notably, Herz states, "The target objects may be published articles, purchasable items, or even other people. . . . Examples of target objects can include, but are not limited to: a newspaper story of potential interest, a movie to watch, an item to buy, e-mail to receive, or another person to correspond with." Col. 6, lines 7-13 (emphasis added).

With this in mind, it is clear that Herz does not even come close to the present invention, as claimed. Herz has nothing to do with a technique for addressing a communication, as the present invention does, and certainly does not disclose or suggest identifying a potential recipient of a communication as a suggested recipient based on an evaluation of a correspondence between content of the communication and content of the descriptive profile of the potential recipient, and then presenting the suggested recipient to a sender of the communication for selection as a confirmed recipient after the sender has composed a draft of the communication and before transmission of the communication to an actual recipient.

Consider the following scenario: If the target object in Hertz is an "e-mail to receive" (as stated in Herz), then the recipient in that case (the "user" in Herz) is not presented to the sender of the communication (the target object) for selection as a confirmed recipient, as required by claim 1. In Hertz, only the user (the recipient in this scenario) decides whether he will actually see a particular target object (see col. 5, lines 17-18), not the sender or even the system. Therefore, this scenario does not read on claim 1.

Consider next the scenario in which the target object in Hertz is "another person to correspond with" (as stated by Herz). In that case, if the "potential recipient" in claim 1 is interpreted to be that other person to correspond with, the system in Herz does not suggest that person (the target object) as a recipient to the user (sender) based on an evaluation of a communication which may be sent to that person (the target object), as required by claim 1. (This should not be surprising since, as previously noted, Herz is not directed to a technique of addressing a communication.) And, if the "potential recipient" in claim 1 is interpreted to be the user himself in Herz, then the system in Herz does not suggest that person (the user) as a recipient to the other person (the sender, in this case) at all, much less doing so based on an evaluation of a communication which may be sent to the user. Therefore, this scenario (where the target object is "another person to correspond with") also does not read on claim 1.

Indeed, there is no interpretation of Hertz which reads on claim 1 of the present application. Therefore, claim 1 and all claims which depend on it are patentable over the cited art.

Each of Applicants' other independent claims includes limitations similar to those discussed above. Therefore, all pending claims are patentable over the cited art.

Dependent Claims

In view of the above remarks, a specific discussion of the dependent claims is considered to be unnecessary. Therefore, Applicant's silence regarding any dependent claim is not to be interpreted as an agreement with, or acquiescence to, the rejection of such claim or as waiving any argument regarding the claim.

Conclusion

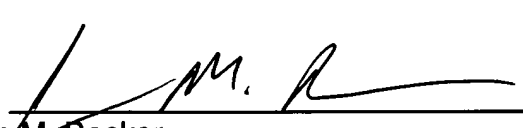
For the forgoing reasons, Applicants respectfully request reversal of the rejections in the Final Office Action.

If any additional fee is required, please charge deposit account No. 02-2666.

Respectfully submitted,

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Date: 12/18/06


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